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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
07/762,762	09/16/91	THOMPSON G	CGNE-69-4

EXAMINER
MOODY, P

CALGENE, INC.
1920 FIFTH ST.
DAVIS, CA 95616

ART UNIT	PAPER NUMBER
1804	13

DATE MAILED: 10/09/92

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 9-16-91 and 11-18-91 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire ONE(1) month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, Form PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 1-67 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☐ Claims _____ are rejected.

5. ☐ Claims _____ are objected to.

6. ☒ Claims 1-67 are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).

12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
    ☐ been filed in parent application, serial no. _____; filed on _____

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

PTOL-326 (Rev. 9-89)

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-17, 50-56, and 60-61, drawn to DNA construct and cells containing same, classified in Classes 435 and 536, subclasses 240.4 and 27, respectively, for example.

II. Claims 18-26 and 33-41, drawn to a first process of using the product of Group I, classified in Class 435, subclass 173.1, for example.

Claims 18, 21, and 26 are generic to a plurality of disclosed patentably distinct species comprising:
(a) expressed protein (claim 19); (b) enzyme inhibition (claim 20); (c) triclyceride acyl fatty acid (claims 22, and 33-41); (d) stearate (claim 23); (e) increased saturates (claim 24); and (f) decreased saturates (claim 25). Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species, even though this requirement is traversed.

Furthermore, within species (c), claims 22, 33, 36-37, and 41 are generic to a plurality of disclosed patentably distinct subspecies comprising:
(c1) expressed protein (claim 34); (c2) enzyme inhibition (claim 35); (c3) stearate (claim 38); (c4) increased saturates (claim 39); and (c5) decreased saturates (claim 40). If species (c) is elected, Applicant is required under 35 U.S.C. § 121 to further elect a single disclosed subspecies, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

III. Claims 27-32, drawn to a plant cells and seeds having modified fatty acid content, classified in Classes 435 and 800, subclasses 240.4 and 200, respectively, for example.

Claims 27-32 are generic to a plurality of disclosed patentably distinct species comprising:
(g) expressed protein; (h) enzyme inhibition; (i) triclyceride acyl fatty acid; (j) stearate; (k) increased saturates; and (l) decreased saturates. Applicant is

required under 35 U.S.C. § 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

IV. Claims 42-44, drawn to a first oil, classified in Class 426, subclass 601, for example.

V. Claims 45-49, drawn to a second oil, classified in Class 426, subclass 601, for example.

Claims 45 and 48 are generic to a plurality of disclosed patentably distinct species comprising:
(m) expressed protein (claim 46); (n) enzyme inhibition (claim 47); and (o) increased saturates (claim 49). Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

VI. Claims 57-59, drawn to process of using Group I to make protein, classified in Class 435, subclass 69.1, for example.

VII. Claims 62-64 and 66-67, drawn to a third oil, classified in Class 426, subclass 601, for example.

Claim 62 is generic to a plurality of disclosed patentably distinct species comprising:
(p) unsaturated; (q) oleate; (r) at least 10% stearate; and (s) at least 45% stearate. Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or

identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

VIII. Claim 65, drawn to a fourth oil, classified in Class 426, subclass 601, for example.

The inventions are distinct, each from the other because of the following reasons:

The DNA and plant cells of Groups I and III and species of same are unrelated as claimed and have different properties and are capable of separate manufacture and use and are patentably distinct. Each of the oils of Groups IV-V, VII, and VIII and species of same are unrelated, as claimed, and have different properties and are capable of separate manufacture and use and are patentably distinct.

Inventions Group I and Groups II and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the DNA and plant cell products can be used in a materially different process such as that of either Group II or Group VI to make either oil or protein, respectively.

Inventions Group II and Groups IV-V, VII, and VIII are

related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (M.P.E.P. § 806.05(f)). In the instant case the products can be made by a materially different process such as chemical modification or classical plant breeding techniques.

A telephone call was made to Donna Scherer on 23 September 1992 to request an oral election to the above restriction requirement, but did not result in an election being made. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Any inquiry concerning this communication should be directed to P. Moody (nee Rhodes) at telephone number (703) 308-0196.

P. Moody
Patent Examiner
Group Art Unit 1804

P. Moody PRM
October 6, 1992